



AUS920010819US1

BRIEF IN SUPPORT OF REINSTATEMENT OF APPEAL

THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	§
Michael Wayne Brown, <i>et al.</i>	§ Group Art Unit: 2645
	§
Serial No.: 10/015,281	§ Examiner: Elahee, MD S.
	§
Filed: December 12, 2001	§ Atty Docket No.: AUS920010819US1
	§
Title: Intermediary Device Initiated	§
Caller Identification	§
	§

Mail Stop: Appeal Brief-Patents
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May 23, 2005
Date
Catherine Berglund
Catherine Berglund

SUPPLEMENTAL APPEAL BRIEF IN SUPPORT
OF REINSTATEMENT OF APPEAL

Honorable Commissioner:

This is an Appeal Brief in support of reinstatement of the Appeal filed pursuant to 37 CFR § 41.37 in response to the Examiner's reopening of prosecution in the Office Action of March 24, 2005 received in response to Applicant's Appeal Brief filed on December 7, 2004. Applicants hereby request that the Appeal in this case be reinstated. A Notice of Appeal pursuant to 37 CFR § 41.31 is filed herewith.

REAL PARTY IN INTEREST

The real party in interest is the patent assignee, International Business Machines Corporation ("IBM"), a New York corporation having a place of business at Armonk, New York 10504.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

STATUS OF CLAIMS

Claims 1-21, 52, and 53 are pending in the case. All pending claims are on appeal.

STATUS OF AMENDMENTS

No amendments were submitted after final rejection. The claims as currently presented are included in the Appendix of Claims that accompanies this Appeal Brief.

SUMMARY OF CLAIMED SUBJECT MATTER

Applicants provide the following concise summary of the claimed subject matter according to 37 CFR§ 41.37(c)(1)(vii), including references to the specification by page and line number and to the drawing(s) if any, by reference characters.

Methods, systems, and products are provided for externally identifying a particular caller that described for example at page 12, line 24 – page 18, line 5 with reference to Figure 1; page 32, line 25 – page 39, line 15 with reference to Figure 4; and page 37, line 17 – page 39, line 15 with reference to Figure 5. Embodiments include receiving a voice utterance for a caller at a server external to a trusted telephone network (S24 of Figure 5) and identifying a caller identity associated with the voice utterance at the server (S25 of Figure 5), such that the caller identity is transmittable within the trusted telephone network as an authenticated identity of a caller for a call (S26 of Figure 5).

Methods, systems, and products for specifying telephone services for a particular caller are also described for example at page 12, line 24 – page 18, line 5 with reference to

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Figure 1; page 32, line 25 – page 39, line 15 with reference to Figure 4; and page 37, line 17 – page 39, line 15 with reference to Figure 5. Embodiments include detecting a call initiation condition from an origin device at a trusted telephone network (S1 and S2 of Figure 5); brokering a connection between said origin device and an external server enabled to perform a caller identity authentication service (S20, S21 and S22 of Figure 5); and responsive to receiving, from said external server, an authenticated caller identity of a caller utilizing the origin device, specifying services available to the caller according to said authenticated caller identity (S9 and S10 of Figure 4).

All such references to the specification identify descriptions and discussions that are part of the detailed descriptions of exemplary embodiments of the present invention in the present application. Such descriptions and discussions are not limitations of the claims in the present application. The only limitations of the claims are set forth in the claims themselves.

GROUND OF REJECTION

Claim 52 stands rejected under 35 U.S.C § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Claims 1-2, 5-6, 8-11, 14-15, and 17-20 stand rejected under 35 U.S.C § 102(e) as being anticipated by Beyda (U.S. Publication No. 2003/0059007). Claims 3 and 12 stand rejected under 35 U.S.C § 103(a) as unpatentable over Beyda in view of Cheston, III, *et al.* (U.S. Patent No. 5,771,279). Claims 4, 13, and 21 stand rejected as unpatentable over Beyda in view of Bartholomew, *et al.* (U.S. Patent No. 6,167,119). Claims 7, 16, and 52-53 stand rejected as unpatentable over Beyda in view of McAllister, *et al.* (U.S. Patent No. 6,442,242). The Office Action of March 24, 2005, also objects to the specification for failing to include the serial numbers of the co-pending applications in page 1.

BRIEF IN SUPPORT OF REINSTATEMENT OF APPEAL**ARGUMENT****HISTORY OF PROSECUTION**

This case has been in prosecution since December 12, 2001. In over three years of prosecution, the four office actions have relied on three different citations of references for rejections under 35 U.S.C § 102(e). The current Office Action of March 24, 2005, relies on Beyda for the rejections under 35 U.S.C § 102(e). The Office Action of March 24, 2005, does not however refer or address the previous rejections contained in the Final Office Action dated August 12, 2004 and traversed in the Appeal Brief of December 7, 2004. To the extent that those previous grounds of rejection are still pending, Applicants hereby incorporate by reference the entirety of the Appeal Brief filed on December 7, 2004, and maintain the traversal of all previous ground of rejection.

OBJECTION TO SPECIFICATION

The Office Action of March 24, 2005, objects to the specification for failing to include the serial numbers of the co-pending applications in page 1. These serial numbers were included by amendment of the specification in the Response to Office Action dated July 16, 2003. The objection should therefore be withdrawn. Applicants' respectfully request that the objection to the specification be withdrawn.

REJECTION UNDER 35 U.S.C § 112, SECOND PARAGRAPH

Claim 52 stand rejected under 35 U.S.C § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Office Action of March 24, 2005, rejections claim 52 stating that the words "said telephony device" in the phrase "an individual with access to said telephony device of the claim" are directed to two telephony devices. Office Action of March 24, 2005, page 3. The phrase "telephony device" in claim 52 is not indefinite and refers to only one telephony device. The phrase "said telephony device" has antecedent

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basis, “a telephony device” in line 3 of the claim. Each subsequent use of the phrase “telephony device” is preceded by the word “said” indicating that the telephony device is the same telephony device introduced in the claim at line 3.

REJECTION UNDER 35 U.S.C § 102(e) OVER BEYDA

Claims 1-2, 5-6, 8-11, 14-15, and 17-20 stand rejected under 35 U.S.C § 102(e) as being anticipated by Beyda. To anticipate claims 1-2, 5-6, 8-11, 14-15, and 17-20 under 35 U.S.C. § 102(e), two basic requirements must be met. The first requirement of anticipation is that Beyda must disclose each and every element as set forth in Applicants’ claims. The second requirement of anticipation is that Beyda must enable Applicants’ claims. Beyda does not meet either requirement and therefore does not anticipate Applicants’ claims.

Beyda Does Not Disclose Each and Every Element of
Applicants’ Claims 1-2, 5-6, 8-11, 14-15, and 17-20

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Beyda does not disclose each and every element of claim 1. Independent claim 1 claims:

“A method for externally identifying a particular caller, said method comprising:

receiving a voice utterance for a caller at a server external to a trusted telephone network; and

identifying a caller identity

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said voice utterance at said server, such that said caller identity is transmittable within said trusted telephone network as an authenticated identity of said caller for a call.”

The Office Action of March 24, 2005, states that the voice mail system of Beyda is a “server external to a trusted telephone network” as claimed in claim 1 of the present application and defines a “trusted telephone network” as a network that needs minimal security and an “untrusted telephone networks” to mean a network that needs additional security. There is no citation for support of such an interpretation. Office Action of March 24, 2005, page 3, paragraph 6. Such a naked assertion that a “trusted telephone network” is a network that needs minimal security and an “untrusted telephone network” is a network that needs additional security is improper and insufficient to reject Applicants’ claims. In fact, Beyda does not even mention “trusted telephone networks.” Beyda does not disclose “receiving a voice utterance ... at a server external to a trusted telephone network” as claimed in claim 1 of the present application. Claim 1 is patentable and the rejection should be withdrawn.

Beyda does not disclose “identifying a caller identity associated with said voice utterance at said server” as claimed in claim 1. Beyda identifies a caller from either a phone number associated with a mailbox or a keyed mailbox number associated with the mailbox. Beyda, abstract, paragraph 0030, paragraph 0037. After identifying the caller from either a phone number associated with a mailbox or a keyed mailbox number associated with the mailbox, Beyda discloses confirming a password to allow the previously identified caller to access the voicemail system. Beyda, paragraph 0030, paragraph 0037. Beyda does not disclose “identifying a caller identity associated with said voice utterance at said server.” Claim 1 is patentable and the rejection should be withdrawn.

In addition, Beyda does not disclose a “caller identity ... transmittable within said trusted telephone network.” The Office Action states Beyda discloses a caller identity ... transmittable within said trusted telephone network at Figures 4-6 and page 3, paragraphs

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0032-0037. There is no teaching in Beyda of any caller identity that is transmittable within said trusted telephone network. In fact, Figures 4-6 and page 3, paragraphs 0032-0037 of Beyda discloses a voice mail system that identifies a mail box for a caller and grants the caller access to the voice mail box based upon receiving a password. The voice mail system of Beyda does not address caller identities that are transmittable within trusted telephone networks. In fact, Beyda does not even mention caller identities that are transmittable within trusted telephone networks. Beyda does not disclose each and every element of claim 1. As such, independent claim 1 cannot be anticipated by Beyda and therefore the rejection should be withdrawn and the claim should be allowed.

Claims 2, 5-6, and 8-9 depend from independent claim 1 and include all of the limitations of claim 1. Because Beyda does not disclose each and every element of claim 1, Beyda does not disclose each and every element of claims 2, 5-6, and 8-9. As such, claims 2, 5-6, and 8-9 are also patentable and should be allowed.

Independent claim 10 similarly claims “[a] system for externally identifying a particular caller” including “means for transmitting said caller identity to said trusted telephone network as an authenticated identity of said caller for a call.” As mentioned above, Beyda discloses a voice mail system that identifies a mail box for a caller and grants the caller access to the voice mail box based upon receiving a password. Beyda does not disclose “[a] system for externally identifying a particular caller” including “means for transmitting said caller identity to said trusted telephone network as an authenticated identity of said caller for a call.” As such, independent claim 10 is not anticipated by Beyda and therefore should be allowed.

Rejected dependent claims 11, 14-15 and 17 depend from claim 10 and include all of the limitations of claim 10. Because Beyda does not disclose each and every element of claim 10, Beyda also does not disclose each and every element of claims 11, 14-15 and 17. Claims 11, 14-15 and 17 should be allowed.

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Independent claim 18 recites “[a] computer program product for externally identifying a particular caller” including “means, recorded on said recording medium, for controlling transmission of said caller identity to said trusted telephone network as an authenticated identity of said caller for a call.” As discussed above, Beyda discloses a voice mail system that identifies a mail box for a caller and grants the caller access to the voice mail box based upon receiving a password. Beyda does not disclose “[a] system for externally identifying a particular caller” including “means for transmitting said caller identity to said trusted telephone network as an authenticated identity of said caller for a call.” As such, independent claim 18 is not anticipated by Beyda and therefore should be allowed.

Rejected dependent claims 19-20 depend from claim 18 and include all of the limitations of claim 18. Because Beyda does not disclose each and every element of claim 18, Beyda also does not disclose each and every element of claims 19-20. Claims 18-20 should be allowed.

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Beyda Does Not Enable

Applicants' Claims 1-2, 5-6, 8-11, 14-15, and 17-20

Not only must Beyda disclose each and every element of claims 1-2, 5-6, 8-11, 14-15, and 17-20 of the present invention within the meaning of *Verdegaal* in order to anticipate Applicants' claims, but also Beyda must be an enabling disclosure of Applicants' claims 1-2, 5-6, 8-11, 14-15, and 17-20 within the meaning of *In re Hoeksema*. In *Hoeksema*, the claims were rejected because an earlier patent disclosed a structural similarity to the applicant's chemical compound. The court in *Hoeksema* stated: "We think it is sound law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention." *In re Hoeksema*, 399 F.2d 269, 273, 158 USPQ 596, 600 (CCPA 1968). The meaning of *Hoeksema* for the present case is that unless Beyda places Applicants' claims 1-2, 5-6, 8-11, 14-15, and 17-20 in the possession of a person of ordinary skill in the art, Beyda is legally insufficient to anticipate Applicants' claims 1-2, 5-6, 8-11, 14-15, and 17-20 under 35 USC 102(e). Claims 1-2, 5-6, 8-11, 14-15, and 17-20 are therefore patentable and should be allowed.

Beyda does not enable claim 1. Independent claim 1 claims:

"A method for externally identifying a particular caller, said method comprising:

receiving a voice utterance for a caller at a server external to a trusted telephone network; and

identifying a caller identity associated with said voice utterance at said server, such that said caller identity is transmittable within said trusted telephone network as an authenticated identity of said caller for a call."

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As discussed above, the Office Action of March 24, 2004, states that the voice mail system of Beyda is a “server external to a trusted telephone network” as claimed in claim 1 and defines a “trusted telephone network” as a network that needs minimal security and an “untrusted telephone networks” to mean a network that needs additional security. There is no citation for support of such an interpretation. Office Action of March 24, 2004, page 3, paragraph 6. Such a naked assertion that a “trusted telephone network” is a network that needs minimal security and an “untrusted telephone network” is a network that needs additional security is improper and insufficient to reject Applicants’ claims. In fact, Beyda does not even mention “trusted telephone networks.” Beyda therefore does not place one of skill in the art in possession of “receiving a voice utterance ... at a server external to a trusted telephone network” as claimed in claim 1. As such, Beyda does not enable claim 1. Claim 1 is patentable and the rejection should be withdrawn.

Beyda does not place one of skill in the art in possession of “identifying a caller identity associated with said voice utterance at said server” as claimed in claim 1. Beyda identifies a caller from either a phone number associated with a mailbox or a keyed mailbox number associated with the mailbox. Beyda, abstract, paragraph 0030, paragraph 0037. After identifying the caller from either a phone number associated with a mailbox or a keyed mailbox number associated with the mailbox, Beyda discloses confirming a password to allow the previously identified caller to access the voicemail system. Beyda, paragraph 0030, paragraph 0037. Beyda therefore does not place one of skill in the art in possession of “identifying a caller identity associated with said voice utterance at said server.” Claim 1 is patentable and the rejection should be withdrawn.

In addition, Beyda does not place one of skill in the art in possession of “caller identity ... transmittable within said trusted telephone network.” The Office Action states Beyda discloses a caller identity ... transmittable within said trusted telephone network at Figures 4-6 and page 3, paragraphs 0032-0037. There is no teaching in Beyda of any caller identity that is transmittable within said trusted telephone network. In fact, Figures 4-6 and page 3, paragraphs 0032-0037 of Beyda discloses a voice mail system that identifies a mail box for a caller and grants the caller access to the voice mail box based

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upon receiving a password. The voice mail system of Beyda does not address caller identities that are transmittable within trusted telephone networks. In fact, Beyda does not even mention caller identities that are transmittable within trusted telephone networks. Beyda does not place one of skill in the art in possession of claim 1. As such, independent claim 1 cannot be anticipated by Beyda and therefore the rejection should be withdrawn and the claim should be allowed.

Claims 2, 5-6, and 8-9 depend from independent claim 1 and include all of the limitations of claim 1. Because Beyda does not place one of ordinary skill in the art in possession of claim 1, Beyda does not place one of ordinary skill in the art in possession of claims 2, 5-6, and 8-9. As such, claims 2, 5-6, and 8-9 are also patentable and should be allowed.

Beyda does not enable independent claim 10. Independent claim 10 similarly claims “[a] system for externally identifying a particular caller” including “means for transmitting said caller identity to said trusted telephone network as an authenticated identity of said caller for a call.” Beyda discloses a voice mail system that identifies a mail box for a caller and grants the caller access to the voice mail box based upon receiving a password. Beyda does not disclose “[a] system for externally identifying a particular caller” including “means for transmitting said caller identity to said trusted telephone network as an authenticated identity of said caller for a call.” Beyda therefore does not place one of ordinary skill in the art in possession of claim 10 and is therefore legally insufficient to anticipate claim 10.

Claims 11, 14-15 and 17 depend from claim 10 and include all of the limitations of claim 10. Because Beyda does not place one of ordinary skill in the art in possession of claim 10, Beyda also does not place one of ordinary skill in the art in possession of claims 11, 14-15 and 17. As such, claims 10-11, 14-15 and 17 should be allowed.

Beyda does not enable independent claim 18. Independent claim 18 recites “[a] computer program product for externally identifying a particular caller” including “means, recorded on said recording medium, for controlling transmission of said caller identity to said

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trusted telephone network as an authenticated identity of said caller for a call.” As discussed above, Beyda discloses a voice mail system that identifies a mail box for a caller and grants the caller access to the voice mail box based upon receiving a password. Beyda does not disclose “[a] system for externally identifying a particular caller” including “means for transmitting said caller identity to said trusted telephone network as an authenticated identity of said caller for a call.” Beyda therefore does not place one of ordinary skill in the art in possession of claim 18 and is therefore legally insufficient to anticipate claim 18. As such, claim 18 is therefore patentable and should be allowed.

Rejected dependent claims 19-20 depend from claim 18 and include all of the limitations of claim 18. Because Beyda does not place one of ordinary skill in the art in possession of claim 18, Beyda also does not place one of ordinary skill in the art in possession of claims 19-20. As such, claims 18-20 are not anticipated by Beyda and should be allowed.

CLAIM REJECTIONS – 35 U.S.C. § 103

Claims 3 and 12 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Beyda in view of Cheston, III, *et al.* (U.S. Patent No. 5,771,279). Claims 4, 13, and 21 stand rejected as unpatentable over Beyda in view of Bartholomew, *et al.* (U.S. Patent No. 6,167,119). Claims 7, 16, and 52-53 stand rejected as unpatentable over Beyda in view of McAllister, *et al.* (U.S. Patent No. 6,442,242). Applicants respectfully traverse each rejection.

To establish a prima facie case of obviousness, three basic criteria must be met. *Manual of Patent Examining Procedure* §2142. The first element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to combine the references. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed combination of the references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The third element of a prima facie case of obviousness under 35 U.S.C.

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§ 103 is that the proposed combination of the references must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

Beyda and Cheston

The Combination of Beyda and Cheston

Does Not Teach all of Applicants' Claim Limitations

The combination of Beyda and Cheston does not teach or suggest all of Applicants' claim limitations. To establish a prima facie case of obviousness under 35 U.S.C. § 103 the proposed combination of Beyda and Cheston must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). As described above, Beyda discloses a voice mail system that identifies a mail box for a caller and grants the caller access to the voice mail box based upon receiving a password. Cheston teaches a system for combining services of customer premise equipment ('CPE') and an advanced intelligent network ('AIN'). *See, for example*, Cheston, abstract, column 19, lines 57-61. Cheston does not cure the deficiencies of Beyda. Neither Beyda nor Cheston disclose or suggest "a method for externally identifying a particular caller," "receiving a voice utterance ... at a server external to a trusted telephone network," or a "caller identity ... transmittable within said trusted telephone network" as claimed in claims 3 and 12. In fact, Cheston does not disclose identifying a particular caller at all. The "voice recognition" in Cheston is the ability to "interpret spoken words." That is, voice recognition of Cheston recognizes the words spoken by a caller, not the caller. Cheston, column 20, lines 9-11. As such, the combination of Beyda and Cheston cannot support a prima facie case of obviousness.

No Suggestion or Motivation to Combine Beyda and Cheston

There is no suggestion or motivation to combine Beyda and Cheston. To establish a prima facie case of obviousness under 35 U.S.C. § 103 there must be a suggestion or motivation to combine Beyda and Cheston. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). As described above, neither Beyda nor Cheston address externally identifying a caller, receiving a voice utterance at a server external to a trusted telephone network, or a caller identity transmittable within said trusted telephone network. Further, Beyda and Cheston operate under different premises. In Beyda, a voice mail system identifies a mail box for a caller and grants the caller access to the voice mail box based upon receiving a password. In Cheston, signaling messages are exchanged between a customer premises network and a public network to coordinate operations. Applicants also respectfully note that the Office Action of March 24, 2005, includes not one word pointing to anything anywhere in the references Beyda and Cheston evidencing their suggestion or motivation to combine the references. As such, the rejection should be withdrawn and the case should be allowed. There is no suggestion in either Beyda or Cheston to combine the references. Therefore, the combination of Beyda and Cheston cannot support a prima facie case of obviousness.

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No Reasonable Expectation of Success in the
Proposed Combination of Beyda and Cheston

To establish a prima facie case of obviousness, there must also be a reasonable expectation of success in the proposed combination of Beyda and Cheston. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). There is no reasonable expectation of success in the proposed combination. Because neither Beyda nor Cheston discloses externally identifying a particular caller, receiving a voice utterance at a server external to a trusted telephone network, or a caller identity transmittable within said trusted telephone network, their combination cannot work to disclose externally identifying a particular caller, receiving a voice utterance at a server external to a trusted telephone network, or a caller identity transmittable within said trusted telephone network. Said differently, Beyda and Cheston cannot together work to disclose what is not disclosed in either reference alone. The combination therefore fails to establish a prima facie case of obviousness.

Beyda and Bartholomew

The Combination of Beyda and Bartholomew
Does Not Teach all of Applicants' Claim Limitations

The combination of Beyda and Bartholomew does not teach or suggest all of the limitations of Applicants' claims 4, 13, and 21. To establish a prima facie case of obviousness under 35 U.S.C. § 103 the proposed combination of Beyda and Bartholomew must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). As described above, Beyda discloses a voice mail system that identifies a mail box for a caller and grants the caller access to the voice mail box based upon receiving a password. Bartholomew describes a single network that provides communication services including intelligent peripherals and TCP/IP network connections. *See* U.S. Patent No. 6,167,119, column

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17, line 62 – column, 18, line 25; (“The illustrated IP also *includes* . . .”); column 9, lines 12-13 (“FIG. 1 provides a simplified illustrated of the preferred intelligent telephone network for implementing the personal dial tone service in accord with the present invention.”); column 11, line 63 – 66 (“The preferred telephone network *includes* one or more intelligent peripherals (IPs)...”); and Figure 1. Bartholomew’s single network does not cure the deficiencies of Beyda. Neither Beyda nor Bartholomew disclose or suggest “a method for externally identifying a particular caller,” “receiving a voice utterance ... at a server external to a trusted telephone network,” or a “caller identity ... transmittable within said trusted telephone network” as claimed in claims 4, 13, and 21. As such, the combination of Beyda and Bartholomew cannot support a prima facie case of obviousness.

No Suggestion or Motivation to Combine Beyda and Bartholomew

There is no suggestion or motivation to combine Beyda and Bartholomew. To establish a prima facie case of obviousness under 35 U.S.C. § 103 there must be a suggestion or motivation to combine Beyda and Bartholomew. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). As described above, neither Beyda nor Bartholomew address externally identifying a caller, receiving a voice utterance at a server external to a trusted telephone network, or a caller identity transmittable within said trusted telephone network. In fact, Bartholomew teaches away from “externally identifying a particular caller” by instead teaching a single preferred network. Teaching away from the claims is a per se demonstration of lack of prima facie obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988); *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Neilson*, 816 F.2d 1567, 2 U.S.P.Q.2d 1525 (Fed. Cir. 1987). Therefore, the combination of Beyda and Bartholomew cannot support a prima facie case of obviousness.

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No Reasonable Expectation of Success in the
Proposed Combination of Beyda and Bartholomew

To establish a prima facie case of obviousness, there must also be a reasonable expectation of success in the proposed modification of Beyda. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). There is no reasonable expectation of success in the proposed combination. Because neither Beyda nor Bartholomew discloses externally identifying a caller, receiving a voice utterance at a server external to a trusted telephone network, or a caller identity transmittable within said trusted telephone network., their combination cannot work to disclose externally identifying a caller, receiving a voice utterance at a server external to a trusted telephone network, or a caller identity transmittable within said trusted telephone network. Said differently, Beyda and Bartholomew cannot together work to disclose what is not disclosed in either reference alone. The combination therefore fails to establish a prima facie case of obviousness.

Beyda and McAllister

The Combination of Beyda and McAllister
Does Not Teach all of Applicants' Claim Limitations

The combination of Beyda and McAllister does not teach or suggest all of the limitations of Applicants' claims 7, 16, 52 and 53. To establish a prima facie case of obviousness under 35 U.S.C. § 103 the proposed combination of Beyda and McAllister must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Neither Beyda nor McAllister teach or suggest all of the limitations of claims 7 and 16. As described above, Beyda discloses a voice mail system that identifies a mail box for a caller and grants the caller access to the voice mail box based upon receiving a password. McAllister describes telephone auto attendant systems including a telephone directory for routing calls to a subscriber

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by receiving the spoken name of a called party, retrieving a telephone number for that called party and forwarding the telephone number of the called party to a PBX to complete the call. *See* McAllister, column 1, line 7; column 2, lines 29-30; and column 5, lines 32-67. McAllister does not even address trusted and untrusted telephone networks or externally identifying a particular caller as defined by Applicants' claims and specification. McAllister does not cure the deficiencies of Beyda. Neither Beyda nor McAllister disclose or suggest "a method for externally identifying a particular caller," "receiving a voice utterance ... at a server external to a trusted telephone network," or a "caller identity ... transmittable within said trusted telephone network" as claimed in claims 7 and 16.

Further, neither Beyda nor McAllister teach or suggest all of the limitations of claims 52 and 53. Claim 52 claims "receiving ... a caller identity ... at a telephony device" such that an "individual with access to said telephony device is informed of the identity of said caller." The Office Action of March 24, 2005, states that Beyda teaches "receiving ... a caller identity ... at a telephony device" such that an "individual with access to said telephony device is informed of the identity of said caller." As discussed above, Beyda discloses a voice mail system that identifies a mail box for a caller and grants the caller access to the voice mail box based upon receiving a password. Beyda does not teach or suggest an individual with access to a telephony device that is informed of the identity of a caller. As described above, McAllister describes telephone auto attendant systems including a telephone directory for routing calls to a subscriber by receiving the spoken name of a called party, retrieving a telephone number for that called party and forwarding the telephone number of the called party to a PBX to complete the call. *See* McAllister, column 1, line 7; column 2, lines 29-30; and column 5, lines 32-67. McAllister does not teach or suggest an individual with access to a telephony device that is informed of the identity of a caller.

Beyda and McAllister also do not teach or suggest all of the limitations of claim 53.

Claim 53 claims:

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“receiving, at a telephony device, a secure communication channel via a trusted telephone network to an authentication service, wherein said trusted telephone network initiates said authentication service; and

facilitating, from said telephony device, communications between said authentication service and a caller, such that said authentication service is enabled to authenticate an identity of said caller.”

The Office Action of March 24, 2005, states that claim 53 is rejected for the same reasons as claim 52. Office Action of March 24, 2005, paragraph 10. Claim 53 is, however, different from claim 52. There is no mention in claim 52 of a “secure communication channel,” of a “trusted telephone network initiat[ing an] authentication service,” or “facilitating, from said telephony device, communications between said authentication service and a caller.” In fact, neither Beyda nor McAllister teach or suggest these limitations. As discussed above, Beyda discloses a voice mail system that identifies a mail box for a caller and grants the caller access to the voice mail box based upon receiving a password. Beyda does not teach or suggest a “secure communication channel,” of a “trusted telephone network initiat[ing an] authentication service,” or “facilitating, from said telephony device, communications between said authentication service and a caller.” Also as described above, McAllister describes telephone auto attendant systems including a telephone directory for routing calls to a subscriber by receiving the spoken name of a called party, retrieving a telephone number for that called party and forwarding the telephone number of the called party to a PBX to complete the call. *See* McAllister, column 1, line 7; column 2, lines 29-30; and column 5, lines 32-67. McAllister does not teach or suggest a “secure communication channel,” of a “trusted telephone network initiat[ing an] authentication service,” or “facilitating, from said telephony device, communications between said authentication service and a caller.”

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No Suggestion or Motivation to Combine Beyda and McAllister

There is no suggestion or motivation to combine Beyda and McAllister. To establish a prima facie case of obviousness under 35 U.S.C. § 103 there must be a suggestion or motivation to combine Beyda and McAllister. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). Applicants respectfully note that the Office Action of March 24, 2005, includes not one word pointing to anything anywhere in the references Beyda and McAllister evidencing their suggestion or motivation to combine the references. As such, the rejection should be withdrawn and the case should be allowed.

No Reasonable Expectation of Success in the
Proposed Combination of Beyda and McAllister

To establish a prima facie case of obviousness, there must also be a reasonable expectation of success in the proposed combination of Beyda and McAllister. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). There is no reasonable expectation of success in the proposed combination with respect to the limitations of claims 7 and 16. Because neither Beyda nor McAllister discloses externally identifying a particular caller, receiving a voice utterance at a server external to a trusted telephone network, or a caller identity transmittable within said trusted telephone network, the combination cannot work to disclose externally identifying a particular caller, receiving a voice utterance at a server external to a trusted telephone network, or a caller identity transmittable within said trusted telephone network.

Similarly, there is no reasonable expectation of success in the proposed combination with respect to the limitations of claims 52 and 53. Because neither Beyda nor McAllister discloses a secure communication channel, a trusted telephone network initiating an authentication service, or facilitating from a telephony device communications between said authentication service and a caller, their combination

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cannot work to disclose a secure communication channel, a trusted telephone network initiating an authentication service, or facilitating from a telephony device communications between said authentication service and a caller. Said differently, Beyda and McAlister cannot together work to disclose what is not disclosed in either reference alone. The combination therefore fails to establish a prima facie case of obviousness.

The Four Factual Inquires Required By The Supreme Court For An Obviousness Rejection Have Not Been Properly Considered, Determined, And Applied

Establishing a prima facie case of obviousness for claims 3-4, 7, 12-13, 16, 21, and 52-53, which has not been accomplished, is not the end of obviousness analysis, it is the beginning. The rejection of these claims under 35 U.S.C. 103 are deficient because the proper factual inquiries have not been considered, determined, and applied as required by the Supreme Court in *Graham v. John Deere*. The rejection should therefore be withdrawn and the case allowed.

The Manual of Patent Examining Procedure §2141 explicitly states:

Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case. The Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), stated:

Under Section 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy. . .

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This is not to say, however, that there will not be difficulties in applying the nonobviousness test. What is obvious is not a question upon which there is likely to be uniformity of thought in every given factual context. The difficulties, however, are comparable to those encountered daily by the courts in such frames of reference as negligence and scienter, and should be amenable to a case-by-case development. We believe that strict observance of the requirements laid down here will result in that uniformity and definitiveness which Congress called for in the 1952 Act.

Office policy has consistently been to follow *Graham v. John Deere Co.* in the consideration and determination of obviousness under 35 U.S.C. 103. As quoted above, the four factual inquiries enunciated therein as a background for determining obviousness are briefly as follows:

- (A) Determining of the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

Manual of Patent Examining Procedure §2141.

In over three years of prosecution, the Examiner has yet to even mention the four factual inquiries required by the Supreme Court in *Graham v. John Deere*, and none of the four factual inquiries has been properly considered, determined, and applied in any of the office actions in this case.

The first factual inquiry that has not been properly considered and determined is ascertaining the differences between the prior art and the claims in issue. More particularly, in each office action, the Examiner has only identified elements in Applicants' claims not found in *Beyda* and then attempted to find a similar element in another reference to support an obviousness rejection. Such analysis is improper and incomplete. "Ascertaining the differences between the prior art and the claims at issue requires interpreting the claim language, and considering both the invention and the prior

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art references as a whole.” MPEP §2141.02. Furthermore, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” *Id.*, citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983). The office actions of April 23, 2003, October 8, 2003, and August 12, 2004 are deficient because the Examiner has only identified differences between Applicants’ claims, Beyda, Bartholomew, Cheston, and McAllister. This analysis is improper and incomplete because Examiner has not determined whether Applicants’ claims as a whole would have been obvious in view of a combination of Beyda and Bartholomew or McAllister or Cheston as required by the Manual of Patent Examining Procedure. In fact, the Examiner has not even mentioned how any claim as a whole would be obvious in rejecting any claim. As such, the obviousness rejections should be withdrawn and the case should be allowed.

The second factual inquiry that has not been properly considered, determined, and applied is resolving the level of ordinary skill in the pertinent art. “The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry.” MPEP §2141.03 citing *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718, 21 USPQ2d 1053, 1057 (Fed. Cir. 1991). “The examiner must ascertain what would have been obvious to one of ordinary skill in the art at the time the invention was made, and not to the inventor, a judge, a layman, those skilled in remote arts, or to geniuses in the art at hand.” *Id.* citing *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1983), cert. denied, 464 U.S. 1043 (1984). “Factors that may be considered in determining level of ordinary skill in the art include (1) the educational level of the inventor; (2) type of problems encountered in the art; (3) prior art solutions to those problems; (4) rapidity with which innovations are made; (5) sophistication of the technology; and (6) educational level of active workers in the field.” *Id.* citing *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 696, 218 USPQ 865, 868 (Fed. Cir. 1983), cert. denied, 464 U.S. 1043 (1984). The office actions of April 23, 2003, October 8, 2003, August 12, 2004, and March 24, 2005 fail to apply a single factor to consider in determining the level of ordinary skill in the art. In fact, in over

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three years of prosecution and four office actions, no analysis at all considering the level of one of ordinary skill in the art for the instant case has been performed. The rejection is therefore deficient and the case should be allowed.

CONCLUSION

Beyda does not disclose each and every element of claims 1-21, 52, and 53. Beyda therefore does not anticipate claims 1-21, 52, and 53. The proposed combinations of Beyda and Cheston, Beyda and Bartholomew, and Beyda and McAllister also fail to establish a prima face case of obviousness because the proposed combinations do not disclose each and every element of the rejected claims, there is no suggestion or motivation to make the proposed combinations, and there is no reasonable expectation of success in the proposed combinations. Applicants respectfully request the allowance of claims 1-21, 52, and 53.

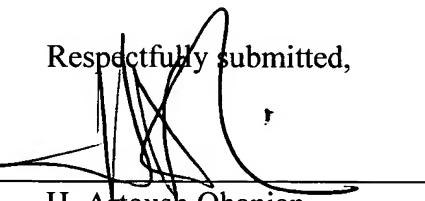
In view of the forgoing arguments, reversal on all grounds of rejection is requested.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Date: May 23, 2005

By: _____

Respectfully submitted,


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APPENDIX OF CLAIMS
ON APPEAL IN PATENT APPLICATION OF
MICHAEL WAYNE BROWN, *ET AL.*, SERIAL NO. 10/015,281

CLAIMS

What is claimed is:

1. A method for externally identifying a particular caller, said method comprising:

receiving a voice utterance for a caller at a server external to a trusted telephone network; and

identifying a caller identity associated with said voice utterance at said server, such that said caller identity is transmittable within said trusted telephone network as an authenticated identity of said caller for a call.

2. The method for externally identifying a particular caller according to claim 1, wherein receiving a voice utterance further comprises:

receiving said voice utterance through a secure channel between said server and said trusted telephone network.

3. The method for externally identifying a particular caller according to claim 1, further comprising:

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receiving, at said server, a request for a caller identity authentication service from said trusted telephone network; and

prompting said caller to provide said voice utterance.

4. The method for externally identifying a particular caller according to claim 1, wherein identifying a caller identity further comprises:

extracting speech characteristics from said voice utterance; and

comparing said speech characteristics with a plurality of voice samples stored for identifying a plurality of callers.

5. The method for externally identifying a particular caller according to claim 1, wherein said trusted telephone network comprises at least one public switching telephone network.

6. The method for externally identifying a particular caller according to claim 1, wherein said trusted telephone network comprises a private switching system.

7. The method for externally identifying a particular caller according to claim 1, further comprising:

accessing said server from said trusted telephone network through an Internet connection.

8. The method for externally identifying a particular caller according to claim 1, further comprising:

accessing said server from said trusted telephone network through a private network connection.

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9. The method for externally identifying a particular caller according to claim 1, further comprising:

transferring said caller identity to said trusted telephone network through a secure channel.

10. A system for externally identifying a particular caller, said system comprising:

a server system communicatively connected to a trusted telephone network by an external network;

means for receiving a voice utterance for a caller at said server system;

means for identifying a caller identity associated with said voice utterance;

means for transmitting said caller identity to said trusted telephone network as an authenticated identity of said caller for a call.

11. The system for externally identifying a particular caller according to claim 10, wherein said means for receiving a voice utterance further comprises:

means for receiving said voice utterance through a secure channel between said server system and said trusted telephone network.

12. The system for externally identifying a particular caller according to claim 10, further comprising:

means for receiving, at said server system, a request for a caller identity authentication service from said trusted telephone network; and

means for prompting said caller to provide said voice utterance.

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13. The system for externally identifying a particular caller according to claim 10, wherein said means for identifying a caller identity further comprises:

means for extracting speech characteristics from said voice utterance; and

means for comparing said speech characteristics with a plurality of voice samples stored for identifying a plurality of callers.

14. The system for externally identifying a particular caller according to claim 10, wherein said trusted telephone network comprises at least one public switching telephone network.

15. The system for externally identifying a particular caller according to claim 10, wherein said trusted telephone network comprises a private switching system.

16. The system for externally identifying a particular caller according to claim 10, wherein said external network is the Internet.

17. The system for externally identifying a particular caller according to claim 10, wherein said external network is a private network.

18. A computer program product for externally identifying a particular caller, said computer program product comprising:

a recording medium;

means, recorded on said recording medium, for enabling receipt of a voice utterance for a caller at a server system communicatively connected to a trusted telephone network via an external network;

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means, recorded on said recording medium, for identifying a caller identity associated with said voice utterance;

means, recorded on said recording medium, for controlling transmission of said caller identity to said trusted telephone network as an authenticated identity of said caller for a call.

19. The computer program product for externally identifying a particular caller according to claim 18, further comprising:

means, recorded on said recording medium, said voice utterance through a secure channel between said server system and said trusted telephone network.

20. The computer program product for externally identifying a particular caller according to claim 18, further comprising:

means, recorded on said recording medium, for enabling receipt at said server system of a request for a caller identity authentication service from said trusted telephone network; and

means, recorded on said recording medium, for prompting said caller to provide said voice utterance.

21. The computer program product for externally identifying a particular caller according to claim 18, further comprising:

means, recorded on said recording medium, for extracting speech characteristics from said voice utterance; and

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means, recorded on said recording medium, for comparing said speech characteristics with a plurality of voice samples stored for identifying a plurality of callers.

52. A method for controlling caller identification, comprising:

receiving, from a trusted telephone network, an authenticated caller identity for a caller at a telephony device, wherein said caller identity is authenticated at a authentication service accessible via a network external to said trusted telephone network, wherein said trusted telephone network initiates said authentication service; and

controlling output of said authenticated caller identity from said telephony device, such that an individual with access to said telephony device is informed of the identity of said caller.

53. A method for controlling a call, comprising:

receiving, at a telephony device, a secure communication channel via a trusted telephone network to an authentication service, wherein said trusted telephone network initiates said authentication service; and

facilitating, from said telephony device, communications between said authentication service and a caller, such that said authentication service is enabled to authenticate an identity of said caller.